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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,070	08/06/2003	Michael J. Czaplicki	1001-009C2	7212
25215	7590	12/20/2004	EXAMINER	
DOBRUSIN & THENNISCH PC 29 W LAWRENCE ST SUITE 210 PONTIAC, MI 48342			JIMENEZ, MARC QUEMUEL	
			ART UNIT	PAPER NUMBER
			3726	

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/635,070

Applicant(s)

CZAPLICKI ET AL

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 20-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31-40 is/are allowed.
- 6) ☒ Claim(s) 20,21,24-27,29 and 30 is/are rejected.
- 7) ☒ Claim(s) 22,23 and 28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09302004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "line 3-3" described on page 3, line 11 of the specification and reference sign "24" is not shown in figures 4-5 as mentioned in the description. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Information Disclosure Statement***

2. Acknowledgement is made of receipt of the Supplemental Information Disclosure Statement filed on 9/30/04 which included an attachment of some of the Foreign Patent Documents and Non Patent Literature listed therein. The Foreign Patent Documents have been entered into the image file wrapper of the instant application. It is noted however, that some of the Foreign Patent Documents and Non Patent Literature Documents have not been received in the instant application. The Foreign Patent Documents and Non Patent Literature Documents that

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the Examiner has not yet considered include those that have been lined through in the Supplemental Information Disclosure Statement attached hereto. Applicant is requested to provide a copy of the Foreign Patent Documents and Non Patent Literature Documents that have been lined through.

3. The "Application of Structural Foam in the body in White - - Reinforcement Roof Rail Side of the OPEL ASTRA" which is listed in the Supplemental Disclosure Statement has been reviewed. Figure 20 of this document appears to show a reinforcement sleeve similar to what is shown in the drawings of the instant application. However, there is no indication of the publication date of this document in the Supplemental Information Disclosure Document.

Applicant is requested to clarify whether this document is available as prior art and the date that this document became available as prior art.

4. The Supplemental Information Disclosure Statement lists documents as "International Search Report dated September 7, 2001" and "International Preliminary Examination Report dated June 25, 2002". Applicant is requested to clarify the serial numbers or any type of identification number of these documents.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 20, 21, 26, 27, 29, and 30** are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Barz et al. (6,131,897).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Barz et al. teach a method of reinforcing an automobile structure, comprising: providing an elongated hollow automobile frame structure having a closed profile (col. 1, lines 5-6), the automobile frame structure defining a hollow center (col. 1, lines 5-6), providing an elongated carrier **30** having a longitudinal axis extending from a first open end to a second open end (reference numeral **36** indicates openings at both ends of the carrier **30**) wherein the carrier **30** includes: i) at least one opening extending therethrough **40**, ii) a plurality of axially extending ribs **48**; and iii) a contoured exterior surface having at least one sloping wall **26** extending from adjacent the first open end to the second open end **36**; and applying a reinforcing medium **42** to the carrier **30** for forming a sleeve (figure 3) wherein the reinforcing medium **42** is a heat activated expandable material (abstract, lines 2-3) that extends along at least a portion of the length of the carrier **30**, inserting the sleeve (figure 3) in the hollow center of the hollow frame structure (col. 1, lines 5-6) such that there is a clearance between the sleeve and the automobile frame structure.

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It is noted that the portion of the locator pin 48 which extends into the carrier 30 is considered a "rib". Although Barz et al. show only one locator pin 48 in figure 3, it is inherent that there would be a plurality of these locator pins along the length of the carrier 30 in order to properly attach the carrier to the automobile frame structure as described in col. 3, lines 31-34. Alternatively, official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have provided more than one rib, in order to securely fasten the carrier to the automobile frame structure. Furthermore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided more than one rib in Barz et al., since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 21, the carrier is asymmetrical about its longitudinal axis as shown in figure 3.

Regarding claim 26, there is a clearance between the sleeve and the beam (col. 5, lines 1-8).

Regarding claim 27, see col. 4, lines 20-62 for the foamed material used.

Regarding claim 29, the reinforcing medium substantially covers an entire outer surface of the carrier (col. 3, lines 37-38).

Regarding claim 30, note that adhesive is used (col. 3, lines 64-65).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section, 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 24 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Barz et al.

Barz et al. teach that the carrier could be made of high-strength plastics (col. 2, line 63).

However, Barz et al. do not specifically teach injection molding the carrier.

Official notice is taken that it was well known to a person of ordinary skill in the art, at the time of the invention, to have used injection molding, in order to provide a part having a complicated cross sectional detail.

#### *Allowable Subject Matter*

9. **Claims 31-40** are allowed.
10. **Claims 22, 23, and 28** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Response to Arguments*

11. Applicant's arguments with respect to claims 20, 21, 24-27, 29, and 30 have been considered but are moot in view of the new ground(s) of rejection.

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12. Applicant's arguments, see page 7, under the heading "Drawings", filed 9/30/04, with respect to the objection to figure 1 as needing a "Prior Art" label have been fully considered and are persuasive. The objection to figure 1 requiring a "Prior Art" label has been withdrawn.

13. Applicant's arguments, see page 8, under the heading "Claim Rejections – 35 USC 112", filed 9/30/04, with respect to the rejection of claims 20-36 as being indefinite have been fully considered and are persuasive. The rejections under 35 USC 112 2<sup>nd</sup> paragraph of claims 20-36 have been withdrawn.

14. Applicant's arguments on page 9, lines 1-7 and the submission labeled "Declaration under C.F.R. section 1.131" swearing behind the Hopton et al. reference have been considered and are persuasive. The rejections based upon the Hotpon et al. reference have been withdrawn.

#### ***Contact Information***


15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number (571) 272-4530. The examiner can normally be reached on Monday-Friday between 5:30 a.m.-2:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 273-4530. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Marc Jimenez  
Primary Examiner  
AU 3726

**MJ**

December 11, 2004